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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,411	03/24/2004	Frank Muir	08740001AA	3860
30743	7590	11/30/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			DANIELS, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/807,411

Applicant(s)

MUIR, FRANK

Examiner

Matthew J. Daniels

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/24/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a method of making a cap with built-in magnification, classified in class 264, subclass 320.
  - II. Claims 12-16, drawn to a cap having built-in magnification, classified in class 215, subclass 228.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a different process can be used to form the cap. A magnifying member can be placed into a mold and then plastic injected into the mold around the member to form a top edge portion and the annular bottle engaging portion.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Michael Whitham on September 29, 2005 a provisional election was made **with** traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims

Art Unit: 1732

12-16 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-3, 6, 7, and 9-11** are rejected under 35 U.S.C. 102(b) as being anticipated by Owens (USPN 2635289). The Examiner submits that Owens' annular shape is suitable for engaging a bottle, and therefore meets all intended use limitations drawn to engaging of bottles or serving as a bottle cap. **As to Claim 1**, Owens teaches: A method of making a bottle cap with a built-in magnification feature (Figs. 20-30), comprising the step of pressing a piece of plastic (Figs. 62, 63) into the shape of a bottle cap having a top portion (Fig. 30, Items 284,281) and an annular bottle engaging portion (Fig. 30, Items 286,285), said top portion having upper and lower surfaces (Fig. 30, Item 281) wherein at least one of said upper and lower surfaces is convex (See Item 281) and having a perimeter that extends to said annular bottle engaging portion (See Fig. 30), said upper and lower surfaces providing optical magnification of objects viewed through said top portion (inherent). **As to Claim 2**, Owens teaches the pressing step is achieved using a stamping machine (Figs. 1 and 2). **As to Claim 3**, Owens teaches the annular bottle engaging portion includes thread engaging members (Fig. 30). **As to Claim 6**, Owens teaches the step of selecting a radius of curvature for said upper and lower convex surfaces based

Art Unit: 1732

on a diameter of said bottle cap (this is inherent in that the lens always beets the bottle engaging portion (See Figs. 22-30, for instance). **As to Claim 7**, Owens teaches that the upper and lower surfaces are convex and having an equal radius of curvature (Figs. 25 and 40, for instance). **As to Claim 9**, Owens teaches a flat surface and a convex surface (Fig. 20). Although silent to the top and bottom surfaces, this is a matter of orientation, and Owens' Fig. 20 meets the claimed limitation. **As to Claims 10 and 11**, Owens teaches plastic as an optical lens, which would have inherently have been transparent and translucent (Title, 4:14, 11:69-12:33).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Towns (USPN 2669369). Owens teaches the subject matter of Claim 1 above under 35 USC 102(b). As to Claim 4, Owens teaches compression molding, but is silent to a bottle-engaging portion that includes a lid wall with an inwardly projecting hook region at its base. However, this aspect is taught by Towns (Figs. 1-6). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Towns into that of Owens because a) Owens suggests that a means for fixedly mounting the lens be provided (20:46-48) and Towns provides means for fixedly mounting (Fig. 3), and b) Towns suggests compression molding (2:9), which Owens provides (entire document).

7. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289) in view of Harris (USPN 4401434). Owens teaches the subject matter of Claim 1 above under 35 USC 102(b). As to Claim 5, Owens appears to be silent to separating the top portion and the annular portion along an arc while maintaining a connection between the top portion and the annular portion along a straight section, the top portion being rotatably moveable in hinge like fashion along a straight section. However, Harris teaches that it is known to separating the top portion and the annular portion along an arc while maintaining a connection between the top portion and the annular portion along a straight section, the top portion being rotatably moveable in hinge like fashion along a straight section (Figs. 1, 3, and 4). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Harris into that of Owens in order to provide a kit which is easy to manufacture and market (2:12-14), adapted for easy storage and maintenance of all the components needed in a single location (2:1-11), and maintaining the viewer in a convenient position (2:29-40).

8. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (USPN 2635289). Owens teaches the subject matter of Claim 6 above under 35 USC 102(b). As to Claim 8, Owens appears to be silent to the different curvatures. However, the it is the Examiner's position that the particular radius chosen does not materially affect the method of making, and therefore is not given patentable consideration. However, in the alternative, Owens clearly teaches in Figs. 20-30A, and it is well recognized in the art, that the radius of an optical

Art Unit: 1732

precision element is a result effective variable depending on the desired magnification of the optical element. As such, the radius of the lens is a result-effective variable that can be changed and optimized. See MPEP 2144.05 II and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to vary and optimize the radii of the two convex lens faces in order to provide a particular magnification.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 11/19/05



MICHAEL P. COLAIANNI  
SUPERVISORY PATENT EXAMINER